

### Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed December 31, 2009. Currently, claims 13-22, 24, 31, 33, and 34 remain pending. Claims 13-22, 24, 31, 33, and 34 have been rejected. Favorable consideration of the following remarks is respectfully requested.

### Claim Rejections – 35 USC § 102/103

“A rejection under 35 U.S.C. 102/103 can be made when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic.” (MPEP 2112, III.)

The Examiner does not appear to have identified an inherent characteristic concerning which Kleshinski is silent and thus which might qualify as a justification for a 102/103 rejection. Accordingly, the rejection will be addressed as separate § 102 and § 103 rejections.

### Claim Rejections – 35 USC § 102

Claims 13-17, 19-21, 24, 31, and 33-34 were rejected under 35 U.S.C. 102(b) as anticipated by Kleshinski (U.S. Patent No. 5,776, 162). After careful review, Applicant must respectfully traverse this rejection.

*“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”* Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (See MPEP § 2131). Nowhere does Kleshinski appear to teach or suggest, a plurality of elongated filter legs each having proximal section and a distal section and each having a centering configuration and a filtering configuration “wherein the centering configuration of said plurality of elongated filter legs includes a bend region in the proximal section forming a pad configured to abut a vessel interior wall to center the filter when placed within a blood vessel” and “wherein each filter leg is configured to avoid contact with the vessel wall in the proximal section of the filter leg in the filtering configuration”, as recited in independent claims 13 and 24.

Instead, Kleshinski appears to teach “filter 10 is a double filter, having a first filter basket 16 and a second filter basket 18. The two filter baskets provide peripheral portions which engage the inner wall of the vein at two longitudinally spaced locations”. Neither of the two filter baskets appears to possess component legs having the characteristics of a filter leg as recited in claims 13 and 24.

Filter basket 16 of Kleshinski is characterized as: “The loops 20 effectively divide the cross-sectional area to be filtered. The peripheral portions or tips of the loops 20 press outwardly against the inner wall of the vein, although without becoming imbedded in the vein; loops 20 thereby help to keep filter 10 in place.” and “The mesh is made up a series of seven overlapping loops 20 arranged to form a rosette approximately 25 mm in diameter.” Accordingly, the seven loops 20 appear both to provide filtering action and remain in contact with the wall in both the centering configuration and filtration configurations of the seven overlapping loops. Once the loops contact the vessel wall, they appear to maintain contact as long as the filter is in place.

Filter basket 18 is characterized as: “second filter basket 18 is formed by the six circumferentially spaced free wire ends or legs 22. Attention is directed to the characterizations which indicate that the six legs 22 are not extensions of the seven loops 20, but instead are distinct entities joined at coil 14. [The coil-wrapped central rod of Fig. 1 (without a reference numeral designation) is not a filter leg 22. It appears to be located in a generally axial position with respect to the filter as may be seen by examining legs 22 which are situated both in front of and behind the rod.]

The Examiner’s sketch at page three of the Office Action appears to have arbitrarily designated points along the six legs 22 of the filter 10 of Kleshinski, points which appear to be not structurally or functionally distinct from points lying both proximal and distal of the selected points and between coil 14 and hinged joints 28, to separate the putative proximal section of the filter legs from the distal section. This arbitrary selection does not appear to identify a portion of the six legs 22 which “includes a bend region in the proximal section forming a pad configured to abut a vessel interior wall to center the filter when placed within a blood vessel”. Accordingly the six legs 22 of filter 10 of Kleshinski do not appear to disclose *each and every element as set forth in the claims*. Similarly, the seven loops 20, which together with a portion of each of the six

legs 22 have been designated by the Examiner as that portion of Kleshinski which provides a proximal section, do not appear to be configured to avoid contact with the vessel wall in the proximal section of the filter leg in the filtering configuration, but rather “press outwardly against the inner wall of the vein”. Thus neither the Examiner’s arbitrarily designated distal section nor the arbitrarily designated proximal section disclose *each and every element as set forth in the claims* and Applicant respectfully requests that the §102(b) rejections of independent claims 13 an 24 be withdrawn.

Additionally, for similar reasons as well as others, claims 14-17, 19-21, 31, and 33-34, which depend from claims 13 and 24 respectively, and include significant additional limitations, are believed to be not anticipated by Kleshinski and Applicant respectfully requests that the rejections be withdrawn.

#### **Claim Rejections – 35 USC § 103**

Claims 13-17, 19-21, 24, 31, and 33-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kleshinski (U.S. Patent No. 5,776, 162). After careful review, Applicant must respectfully traverse this rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP § 2143.03). As discussed above, nowhere does Kleshinski appear to teach all the claim limitations recited in independent claims 13 and 24, as is required to establish a *prima facie* case of obviousness. Accordingly Applicant respectfully requests that the rejections of independent claims 13 and 24 be withdrawn.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03)

Accordingly, claims 14-17, 19-21, 31, and 33-34, which depend from nonobvious independent claims 13 and 24 respectively, also are believed to be nonobvious and Applicant respectfully requests that the rejections be withdrawn.

Claim 18 was rejected under 35 U.S.C. 103(a) as being unpatentable over

Kleshinski in view of Boylan et al. (U.S. Patent No. 6,602,272), hereinafter Boylan.

After careful review, Applicant must respectfully traverse this rejection.

Claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kleshinski in view of Mazzocchi et al. (U.S. Patent No. 6,949,103), hereinafter Mazzocchi. After careful review, Applicant must respectfully traverse this rejection.

Claims 18 and 22 both depend from nonobvious independent claim 13 discussed above. Neither the nickel-titanium-cobalt alloy said to be disclosed by Boylan nor the lubricious coating said to be disclosed by Mazzocchi appear as elements of claim 1 and thus those disclosures do not appear to overcome the deficiencies of Kleshinski identified earlier. Accordingly, claim 13 remains nonobvious over Kleshinski in view of either Boylan or Mazzocchi and claims 18 and 22, which depend from nonobvious independent claim 13, are also believed to be nonobvious. Applicant respectfully requests that the rejections be withdrawn.

In the Response to Arguments, the Examiner's response appears to reflect the erroneous belief that a loop of the seven loops 20, forming first basket 16, and a leg of the six legs 22, forming the second basket 18 are different portions of the same element which may be described as partitioned arbitrarily and further that that element corresponds to one of the plurality of elongated filter legs of the pending claims. Instead, the two sets of legs are separate. Each set appears to have a collapsed delivery configuration and an expanded filtering configuration, but no configuration which corresponds to the configuration of the claims wherein the filter legs are configured to filter debris from the blood stream and in which the centering portion of the proximal portion of the legs is no longer "configured to avoid contact with the vessel wall". Basket 16 appears to comprise 7 wires which are collapsed in the delivery catheter and expanded and in contact with the vessel wall while it performs a centering function for the double filter 10 and while it acts as a proximal first filter. So long as it is in a filtering configuration, it appears necessarily to remain in contact with the vessel wall. Basket 18 appears to comprise six wires which are collapsed in the delivery catheter and which have an expanded filtering configuration, but no configuration in which the proximal ends thereof have "a bend region in the proximal section forming a pad configured to abut a

vessel interior wall to center the filter when placed within a blood vessel". Thus the individual baskets of Kleshinski appear to have independent collapsed and expanded configurations, but neither basket (set of loops or set of wires) has a third configuration in which the centering bends in the legs of that basket are no longer in contact with the vessel wall while maintaining the filtering function for that basket. During the staged release of the two basket device of Kleshinski as apparently contemplated by the Examiner, each filter basket appears to have only two configurations and the transition states therebetween, but no state in which a previous wall contact is removed after serving a centering function while continuing to provide a filtration function.

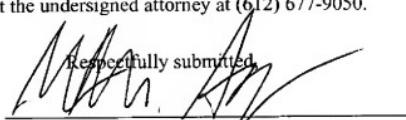
The Examiner, in discussing the limitation previously present in claims 35-36, again relies upon the erroneous assumption that there is an entity corresponding to a leg 20/22 as well as an arbitrary division of that putative entity.

It is unclear how one of ordinary skill in the art would have modified the distribution of seven loops 20 to be equidistantly spaced at 60 degree intervals as recited in the claim in question.

The issue of section 4 appears moot given the inability of loops 20 to provide the additional limitations of the claims.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

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Respectfully submitted,

Glenn M. Seager, Reg. No. 36,926  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
[Glenn.Seager@cstlaw.com](mailto:Glenn.Seager@cstlaw.com)  
Tel: (612) 677-9050  
Fax: (612) 359-9349